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EXAMINER

DURAN, ARTHUR D

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/935,884

Applicant(s)

FOWLER ET AL.

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-67 have been examined.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 6-12, 16-18, 20-25, 27-32, 39-53, 55-62, 67 are rejected under 35 U.S.C. 102(e) as being anticipated by Postrel (20040098317).

Claim 1, 16, 42, 59, 62: Postrel discloses an automated marketing system implemented using a host controller system, comprising:

acquiring a user identifier, a merchant identifier, and a user behavior identifier at a point of transaction and communicating each of the identifiers to a host controller system over a communications network (Fig. 2; Fig. 4; Fig. 5);

validating eligibility of at least one of the user identifier, the merchant identifier and the user behavior identifier to determine eligibility for participation in at least one marketing program (Fig. 2; Fig. 4; Fig. 5; Fig. 6);

performing a rate calculation processing step to determine eligibility of the user, the merchant and the user behavior for an award based on a preselected set of criteria (Fig. 5; Fig. 6; Fig. 4); and

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communicating information relating to delivery of an award or an updated award status condition to the point of transaction over a communications network (Fig. 6; Fig. 4; Fig. 5).

Also, in regards to claim 42, Postrel further discloses accessing a user database from a host controller system, the user database associating a user identifier with additional user demographic information (Fig. 5); associating the user identifier with the additional user demographic information and validating the eligibility of the user to participate in at least one marketing program based on the user identifier and/or the additional user demographic information (Fig. 4; Fig. 5; Fig. 6).

Also, in regards to claim 59, Postrel further discloses validating eligibility of the merchant identifier for redemption of the award; performing a rate calculation processing step to determine whether the award balance satisfies the redemption inquiry and determining a redemption status; communicating the redemption status to the point of transaction (Fig. 4; Fig. 5; Fig. 6).

Also, in regards to claim 62, Postrel further discloses implementing an award program in which successive qualifying behaviors of specified qualifying users at one or more qualifying merchant(s) produces successively different awards (Fig. 4; Fig. 5; Fig. 6; Paragraph [53]; Paragraph [54], 'Access to video games may be afforded to the traveler where the availability of different games depends on the number of reward points traded in by the traveler.'; Paragraph [13, 32, 33]). Notice in these citations from Postrel that the user(s) performs successive qualifying behaviors, acquires more and more points in the system as more behaviors are

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performed, and that the different amounts of user points allows the user access to different awards as the amount of points increases.

Claim 2: Postrel discloses an automated marketing system according to claim 1, additionally comprising updating at least one of a user, merchant and user behavior file and storing the user, merchant and user behavior identifier (Fig. 4; Fig. 5).

Claim 3: Postrel discloses an automated marketing system according to claim 1, additionally comprising communicating information relating to delivery of an award or an updated award status condition to the user at the point of transaction (Fig. 2; Fig. 4; Fig. 5; Fig. 6).

Claim 4, 60, 61: Postrel discloses an automated marketing system according to claim 1, additionally comprising communicating information relating to identification of the user, user behavior, the delivery of an award, or an updated award status condition to the merchant at the point of transaction (Fig. 4; Fig. 5; Fig. 6; Fig. 7).

Claim 6: Postrel discloses an automated marketing system according to claim 1, additionally comprising displaying information relating to delivery of an award or an updated award status condition at the point of transaction (Fig. 2; Fig. 4; Fig. 5; Fig. 6; Fig. 7).

Claim 7: Postrel discloses an automated marketing system according to claim 1, additionally comprising performing an award prioritization processing step after the rate calculating processing step when a transaction is eligible for multiple awards ([33, 46]).

Claim 8: Postrel discloses an automated marketing system according to claim 1, wherein user eligibility for participation in at least one marketing program is based on at least one of the qualifiers selected from the group consisting of membership in

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a participating organization; participation in a loyalty program; participation in a gift card program; holding of a credit instrument; holding of a debit instrument; holding of an account; membership in a subscriber base; participation in a service; and simultaneous or prior purchase of qualifying good(s) or service(s) (Fig. 2; Fig. 4; Fig. 5; Fig. 6; Fig. 7).

Claim 9: Postrel discloses an automated marketing system according to claim 1, wherein the award is expressed in an award currency selected from the group consisting of points, gift cards, gift certificates, instant prizes, custom coupons, merchandise, credit; services; benefits; and cash (Fig. 4; Fig. 5).

Claim 10: Postrel discloses an automated marketing system according to claim 1, wherein the user behavior identifier is selected from the group consisting of: identification of predetermined item(s) purchased; identification of predetermined service(s) purchased; identification of item type purchased; identification of service type purchased; purchase price of individual item(s); purchase price of individual service(s); presence of user in a location; purchase in a location; purchase value total; purchase date; purchase time; purchase location; award delivered; and award accumulated (Fig. 4; Fig. 5).

Claim 11: Postrel discloses an automated marketing system according to claim 1, additionally comprising means for modifying the eligibility of at least one of the user identifier, the merchant identifier and the user behavior identifier to determine eligibility for participation in at least one marketing program (Fig. 6; Fig. 8).

Claim 12: Postrel discloses an automated marketing system according to claim 1, additionally comprising means for modifying the rate calculation processing step for determining eligibility of the user, the merchant and the user behavior for an award based on a modified set of criteria different from the preselected set of criteria (Fig. 4; Fig. 5; Fig. 9).

Claim 17: Postrel discloses an automated marketing system according to claim 1, wherein qualifying customer behaviors are accumulated over a time period to calculate awards ([12], 'period').

Claim 18: Postrel discloses a automated marketing system according to claim 1, wherein the host controller system additionally accesses user behavior historical information based on the user identifier, and the rate calculation processing step determines the eligibility of the user, merchant and user behavior for an award based, at least in part, on the user behavior historical information (Fig. 4; Fig. 5).

Claim 20: Postrel discloses an automated marketing system according to claim 1, additionally comprising implementing multiple marketing programs, involving multiple merchants and/or merchant groups, upon validation of one or more user identifier(s) (Fig. 4; Fig. 5).

Claim 21: Postrel discloses an automated marketing system according to claim 1, additionally comprising implementing multiple marketing programs, involving multiple user identifiers or user identifier groups, upon validation of one or more merchant identifier(s) (Fig. 4; Fig. 5).

Claim 22, 44: Postrel discloses an automated marketing system according to claim 1, additionally comprising acquiring the user identifier and at least one transaction payment identifier in a single step at the point of transaction (Fig. 2; [42]).

Claim 23: Postrel discloses an automated marketing system according to claim 22, wherein the single step at the point of transaction is a single examination of an identifying Object (Fig. 2; [42]).

Claim 24, 43, 45, 46: Postrel discloses an automated marketing system according to claim 22, wherein the single step at the point of transaction is a single card swipe and the card is a financial instrument (Fig. 2; [42, 33]).

Claim 25: Postrel discloses an automated marketing system according to claim 22, wherein the user identifier, the merchant identifier, the user behavior identifier, and at least one transaction payment identifier are acquired in a single step at the point of transaction; the user identifier, the merchant identifier and the user behavior identifier are communicated to the host controller over a communications network; and the at least one transaction payment identifier is additionally communicated to an appropriate financial institution or intermediate for processing (Fig. 2; Fig. 4; Fig. 5; [3, 15, 29, 33]).

Claim 27: Postrel discloses an automated marketing system according to claim 26, wherein the at least one transaction payment identifier is additionally communicated to the host controller over a communications network (Fig. 4; Fig. 5).

Claim 28: Postrel discloses an automated marketing system according to claim 25, wherein user identifier and at least one transaction payment identifier are communicated to

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the host controller over a communications network, and transaction payment identifier is additionally communicated from the host controller to an appropriate financial institution or intermediate for processing ([42; 43, 33]; Fig. 4; Fig. 5).

Claim 29: Postrel discloses an automated marketing system according to claim 22, wherein a credit or debit account identifier is acquired at the point of transaction and is communicated to an appropriate institution for validation and approval (Fig. 4; Fig. 5; Fig. 6).

Claim 30: Postrel discloses an automated marketing system according to claim 29, additionally comprising transmitting the customer identifier to the marketing program host controller following validation and approval of the transaction (Fig. 5).

Claim 31: Postrel discloses an automated marketing system according to claim 1, additionally comprising implementing award redemption at the point of transaction (Fig. 4; Fig. 5; Fig. 6; ([42]).

Claim 32, 51: Postrel discloses an automated marketing system according to claim 31, additionally comprising validating eligibility of at least one of the user identifier, the merchant identifier and user behavior identifier to determine eligibility for award redemption, updating the award status condition based on the award redemption, and communicating information relating to redemption of an award to the point of transaction over a communications network (Fig. 4; Fig. 5; Fig. 6).

Claim 39: Postrel discloses an automated marketing system according to claim 1, additionally comprising analyzing data collected relative to user identifications and/or merchant identifications and/or user behaviors and providing data relating to the analysis to qualifying merchants/merchant groups through an Internet

Website portal ([5, 9, 32]; Fig. 4; Fig. 5).

Claim 40: Postrel discloses an automated marketing system according to claim 1, wherein a data collection device at the point of transaction acquires the user identifier, the merchant identifier and the user behavior identifier, and the data collection device is selected from the group consisting of electronic registers, optical and magnetic scanners and readers, barcode scanners, magnetic strip scanners, radio frequency receivers, transaction card readers, communications devices, computers, personal digital assistants, telephones and pagers (Fig. 2; [42]).

Claim 41: Postrel discloses an automated marketing system according to claim 1, wherein a personal communications device acquires data relating to at least one of a user identifier, a merchant identifier and a user behavior and communicates the data to the host controller system over a communications network ([14, 28]).

Claim 47: Postrel discloses an automated marketing system of claim 1 or claim 42, in which the user identifier information is detected by recognition of a number, a barcode, a fingerprint, a retinal pattern, or a radio frequency signal (Fig. 2; [42]).

Claim 48: Postrel discloses an automated marketing system of claim 1 or 42, in which data is transmitted to the host controller system via local or regional phone lines, dedicated data transmission lines, cable, cellular, personal communication systems, microwave, radio frequency, fiberoptic, global communications networks or satellite networks ([14, 28, 54]).

Claim 49: Postrel discloses an automated marketing system of claim 1 or 42, in which information relating to delivery of an award or an updated award status condition is

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transmitted to the point of transaction via local or regional phone lines, dedicated data transmission lines, cable, cellular, personal communication systems, microwave, radio frequency, fiberoptic, global communications networks or satellite networks ([14, 28, 54]).

Claim 50: Postrel discloses an automated marketing system of claim 1 or 42, additionally comprising converting awards from different marketing programs into a common award currency and calculating and transferring award balances expressed in the common award currency to the host controller system (Fig. 4; Fig. 5).

Claim 52: Postrel discloses an automated marketing system of claim 50, wherein the common award currency is redeemable through any participating merchant or merchant group (Fig. 4; Fig. 5).

Claim 53: Postrel discloses an automated marketing system of claim 1 or 42, additionally comprising validating the eligibility of at least one of the user identifier, the merchant identifier and the user behavior identifier to determine eligibility for participation in multiple marketing programs (Fig. 4; Fig. 5; Fig. 6).

Claim 55: Postrel discloses an automated marketing system of claim 1 or 42, in which the host controller system administers multiple marketing programs associated with multiple merchants and/or merchant groups, and following acquisition and communication of the user identifier, the host controller validates eligibility of the user identifier to determine eligibility for participation in multiple marketing programs (Fig. 4; Fig. 5).

Claim 56: Postrel discloses an automated marketing system of claim 1 or 42, additionally comprising issuing gift certificates in an award currency usable in at least one marketing program administered by the host controller system and redeemable by at least one participating merchant and/or merchant group ([42]).

Claim 57: Postrel discloses an automated marketing system of claim 56, in which the gift certificate in the award currency is associated with the user identifier and communicated to the host controller system, and gift certificate redemption is administered by the host controller system through participating merchants and/or merchant groups (Fig. 5; Fig. 5; Fig. 6).

Claim 58: Postrel discloses an automated marketing system of claim 56, in which the gift certificate information is stored in the host controller system in a common award currency, and is convertible and redeemable through participating merchants and/or merchant groups in multiple currencies (Fig. 4; Fig. 5).

Claim 67: Postrel discloses a system for implementing a marketing program comprising a centralized host controller in communication with a plurality of point of transaction devices by means of a communications system, the centralized host controller additionally in communication with a user/customer database, a merchant database, one or more program matrix rules modules, one or more data management storage & retrieval programs, one or more GIS applications, and a dynamic custom messaging system (Fig. 4; Fig. 5).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 19, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Postrel (20040098317).

Claim 19: Postrel discloses the above. Postrel does not explicitly disclose utilizing user demographic information. However, Postrel disclose utilizing user account information, user credit card information, user smart card information (as disclosed above), user registration/name/login information, and user profile and preference and account information (Fig. 5). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Postrel can utilize user demographic information. One would have been motivated to do this in order to better present the user content of interest ([8, 27]).

Claim 26: Postrel discloses the above. Postrel does not explicitly discloses that the reward program identifier and credit card identifier can be sent to different parties at time of transaction. However, Postrel discloses both a reward program identifier and host and also a credit card identifier and credit card company (Fig. 2; Fig. 4; Fig. 5; [3, 15, 29]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that the separate information concerning the user can be reported to separate

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companies/hosts. One would have been motivated to do this in order to allow the user to utilize different credit cards with the same reward system (Fig. 2; Fig. 4; Fig. 5).

4. Claims 5, 54, 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Postrel (20040098317) in view of Eggleston (6,061,660).

Claim 5, 54, 66: Postrel discloses the above. Postrel does not explicitly disclose printing receipts. However, Postrel discloses printers ([54]).

Eggleston further discloses printing information relating to delivery of an award or an updated award status condition on a transaction receipt generated at the point of transaction (col 45, lines 5-15).

Eggleston further discloses random prizes and a variety of award schemes (Fig. 20).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Eggleston's receipt for awards and variety of prizes and awards to Postrel's awarding a user for certain behaviors. One would have been motivated to do this in order to better track what has been provided to the user (Postrel, Fig. 5) and to provide awards/incentives of interest to the user.

5. Claims 13-15, 63-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Postrel (20040098317) in view of Bednarek (20050251440)

Claim 13-15, 63-65: Postrel discloses the above. Postrel does not explicitly disclose increasing or decreasing awards based on frequency of utilization during a time period.

However, Bednarek discloses increasing or decreasing awards based on frequency of utilization

during a time period (Bednarek, [295, 297, 298]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Bednarek's adaptable rewards to Postrel's variety of awarding structures (Postrel, Fig. 4; Fig. 5). One would have been motivated to do this in order to present awards that better incite certain user behaviors.

6. Claims 33-38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Postrel (20040098317) view of Bednarek (20050251440) in view of Fitzpatrick (20020046138).

Postrel discloses the above. Postrel does not explicitly disclose charging a fee to the sponsors/merchants for utilizing the system.

However, Bedarek discloses increasing or decreasing awards based on frequency of utilization during a time period (Bednarek, [295, 297, 298]).

Fitzpatrick discloses variable fees, flat fees, percentage fees, fees tied to the prizes for an award program ([97, 110, 100]; claims 8, 12, 13, 46).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Fitzpatrick's variable fees tied to the awards and Bedarek's varying awards Postrel's awards program with multiple sponsors. One would have been motivated to do this in order to provide a better way to compensate for the expenses associated with running an awards program.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Arthur Duran', is positioned above the printed name.

Arthur Duran
Primary Examiner
2/7/2006